

08/09/06

13:17

DAVIS MUNCK → 915712738300

NO. 173

001



A PROFESSIONAL CORPORATION
900 THREE GALLERIA TOWER
13155 NOEL ROAD
DALLAS, TEXAS 75240

RECEIVED
CENTRAL FAX CENTER
AUG 09 2006

TELEPHONE (972) 628-3600

FACSIMILE (972) 628-3616

Facsimile Cover Sheet

To: Examiner Alain L. Bashore
USPTO

Fax: (571) 273-8300

From: William A. Munck, Esq.

Time: 2:08 PM

Date: August 9, 2006

Client/Matter: PHIL06-00377

THIS FAX CONSISTS OF 29 PAGE(S) (INCLUDING THIS COVER SHEET).
IF THERE IS A PROBLEM IN RECEIVING THIS FAX, PLEASE CALL (972) 628-3600

Type your content below.

U.S. Serial No. 09/734,808 filed December 12, 2000

THIS FACSIMILE TRANSMISSION IS PRIVILEGED AND CONFIDENTIAL AND IS INTENDED SOLELY FOR THE USE OF THE RECIPIENT NAMED ABOVE. IF YOU ARE NOT THE NAMED RECIPIENT BUT HAVE RECEIVED THIS FAX, YOU ARE HEREBY NOTIFIED THAT THE COPYING, RELEASE, DISTRIBUTION, USE OR RETENTION OF THIS FACSIMILE TRANSMISSION IS STRICTLY PROHIBITED. IF YOU HAVE INADVERTENTLY BEEN DELIVERED THIS FACSIMILE TRANSMISSION, PLEASE CALL US COLLECT AT (972) 628-3600 OR RETURN IT TO US BY U.S. MAIL AT THE LETTERHEAD ADDRESS.

AUG 09 2006

ATTY. DOCKET NO. US 000377
CLIENT NO. PHIL06-00377**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : CAROLYN RAMSEY CATAN
United States Serial No. : 09/734,808
Filed : December 12, 2000
Title : REMOTE CONTROL ACCOUNT AUTHORIZATION
SYSTEM
Art Group Unit : 3624
Examiner : Alain L. Bashore

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION BY FACSIMILE

Sir:

The undersigned hereby certifies that the following documents:

1. Appeal Brief

relating to the above application was faxed to (571) 273-8300 on August 9, 2006.Date: 8/9/06

Faxer

Date: Aug. 9, 2006

William A. Munck

Reg. No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: wmunck@munckbutrus.com

**RECEIVED
CENTRAL FAX CENTER****AUG 09 2006****DOCKET NO.: US 000377
CLIENT NO.: PHIL06-00377****PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Carolyn Ramsey Catan
Serial No.: 09/734,808
Filed: December 12, 2000
For: REMOTE CONTROL ACCOUNT AUTHORIZATION
SYSTEM
Group No.: 3624
Examiner: Alain L. Bashore

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

The Appellants appealed to the Board of Patent Appeals and Interferences ("BPAI") from the decision of the Examiner dated January 11, 2005, finally rejecting Claims 5-11 and Claims 13-16. The Appellants timely filed an Appeal Brief on July 11, 2005 and the BPAI received the Appeal Brief on July 15, 2005. By order dated July 27, 2006 the BPAI returned the Appeal Brief to the Examiner with instructions to have the Appellants submit a substitute Appeal Brief in compliance with the appellate rules set forth in 37 C.F.R. § 41.37(c). Appellants hereby submit this substitute Appeal Brief in accordance with the BPAI's order of July 27, 2006.

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

REAL PARTY IN INTEREST

This application is currently owned by Philips Electronics North America Corporation, as indicated by an assignment recorded on December 12, 2000 in the Assignment Records of the United States Patent and Trademark Office at Reel 011373, Frame 0857.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-4, 12 and 17 have been canceled from the above-identified patent application. Claims 5-11 and 13-16 remain pending in the above-identified patent application. Claims 5-11 and 13-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,845,260 to Nakano et al. ("*Nakano*") in view of U.S. Patent No. 4,837,422 to Dethloff et al. ("*Dethloff*") and U.S. Patent No. 5,721,583 to Harada et al. ("*Harada*"). Claims 5-11 and 13-16 are presented for appeal. Claims 5-11 and 13-16 are shown in Appendix A.

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

STATUS OF AMENDMENTS

No amendments were submitted and refused entry after issuance of the final Office Action dated January 11, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

According to one embodiment, a consumer electronics device 50, shown in Figure 4, is provided with a memory that stores account information for an account holder and sub-credit limits and bioauthentication information for authorized users of the account. (Specification, Page 7, Lines 11-13; Page 8, Lines 3-19). The device further includes a bioauthentication device that provides bioauthentication information to the memory and a processor that compares received bioauthentication information to stored bioauthentication information to detect a match. (Specification, Page 9, Lines 6-11). The processor further finds an associated sub-credit limit corresponding to the received bioauthentication information to enable a purchase over the response network via the communication network up to a maximum of the sub-credit limit. (Specification, Page 9, Lines 11-16). The processor sends the account holder information over a communication link only if the match is detected and the sub-credit limit is not exceeded. (Specification, Page 9, Lines 11-16).

Regarding Claim 5, a consumer electronics device is claimed that comprises (1) a memory that stores account information for an account holder and sub-credit limits and bioauthentication information for authorized users of the account; (2) a bioauthentication

DUCKET NO. US 000377
U.S. SERIAL NO. 09/734,809
PATENT

device that provides bioauthentication information to the memory; (3) a communication link; and (4) a processor that compares received bioauthentication information to stored bioauthentication information to detect a match, and finds an associated sub-credit limit corresponding to the received bioauthentication information, to enable a purchase over the response network via the communication network up to a maximum of the sub-credit limit, the processor sending the account holder information over the communication link only if the match is detected and the sub-credit limit is not exceeded. (Specification, Page 7, Lines 11-13; Page 8, Lines 3-19; Page 9, Lines 6-16).

Regarding Claim 13, a device for locally controlling access to an account is claimed that comprises (1) a local storage device for storing account information of an account holder and sub-credit limits and bioauthentication information for authorized users of the account; (2) a bioauthentication device for obtaining bioauthentication information from authorized users and an account holder; (3) a processor for changing sub-credit limits on the storage device in response to a request from the account holder, provided the account holder has provided bioauthentication information which matches bioauthentication information stored on the local storage device for the account holder, and (4) a communication network for authorizing a transaction on the account and sending the account holder's information in response to a request from an authorized user or account holder provided that the bioauthentication information provided by the authorized user or account holder matches the bioauthentication information of the authorized user or account holder stored on the local storage device and that the transaction does not exceed

DOCKET No. US 000377
U.S. SERIAL No. 09/734,808
PATENT

the sub-credit limit storage on the local storage device of the authorized user or account holder making the request. (Specification, Page 7, Lines 11-13; Page 8, Lines 3-19; Page 9, Lines 6-16).

Regarding Claim 14 a consumer electronics device is claimed that comprises (1) a memory that stores a profile of a user, the profile indicates access levels of the user, and sub credit limits of authorized users of an account; (2) a bioauthentication device that provides bioauthentication information to the memory; (3) a communication link, and (4) a processor that compares received bioauthentication information to stored bioauthentication information to detect a match, and detects the access levels of the profile associated with the matching bioauthentication information to determine whether requested access over the communication link can be given based on the received bioauthentication information, and whether the subcredit limit associated with the received bioauthentication information is enough to complete a requested transaction and sending the account holder information across the communication link only if there is a match and the subcredit limit it not exceeded. (Specification, Page 7, Lines 11-13; Page 8, Lines 3-19; Page 9, Lines 6-16).

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 5-11 and Claims 13-16 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,845,260 to Nakano et al. ("*Nakano*") in view of U.S. Patent No. 4,837,422 to Dethloff et al. ("*Dethloff*") and U.S. Patent No. 5,721,583 to Harada et al. ("*Harada*").

ARGUMENT

The rejections of Claims 5-11 and 13-16 under 35 U.S.C. § 103(a) are improper and should be withdrawn.

A. OVERVIEW

Claims 5-11 and Claims 13-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Nakano* in view of *Dethloff* and *Harada*.

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability of a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)).

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.")

Evidence of a motivation to combine prior art references must be clear and particular if the trap of "hindsight" is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be "clear and particular." "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'")

C. THE NAKANO REFERENCE

Nakano recites a charging system for a parent to control spending by a child. The parent sets an imaginary account 2, shown in Figure 1 and Figure 3, for the child in a remote server/processor 1 of the service provider company. (Column 3, Lines 1-9 and Lines 51-55). When the child selects a

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

desired service on a display device 4, a charge request is sent over a communications link to the remote server/processor 1 via a set-top box 3. (Column 3, Lines 11-15). The charge request includes the child's identification data. (Column 3, Lines 15-17). The remotely located server/processor 1 makes a determination whether the balance in the imaginary account 2 is sufficient or not. (Column 4, Line 62 to Column 5, Line 1). If so, the fee for the service is withdrawn from the imaginary account 2. (Column 5, Lines 25-29). Nakano does not disclose, suggest or even hint at the concept of using bio-authentication information.

D. THE DETHLOFF REFERENCE

The *Dethloff* reference discloses the use of a multi-user "smart card." The *Dethloff* device comprises a plastic "smart card" that contains at least one integrated circuit chip. (*Dethloff*, Column 1, Lines 12-20). The *Dethloff* device is referred to as a multi-user card (or "M-card") because it is capable of storing data and making calculations for each of a plurality of users. The *Dethloff* device assigns a personal identification number (PIN) to each user. (*Dethloff*, Column 6, Lines 32-33). The PIN is used as an authentication code to access the M-card.

The *Dethloff* reference mentions the concept of using a voice print code instead of a PIN for authentication. "It is noted that while the PIN is given as an example of cardholder and sub-user enabling code, any other code can be used, such as a voice print (to be stored as data and input by the cardholder or sub-user) or an algorithm such as a 'trapdoor' algorithm mentioned above." (*Dethloff*, Column 11, Lines 25-30). *Dethloff* does not specifically disclose a "voice sensor"

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

(or any other type of bioauthentication device) within the *Dethloff* M-card.

E. THE HARADA REFERENCE

Harada recites an interactive television system including a remote center apparatus 101, shown in Figure 1, a terminal apparatus 102, a display apparatus 102 and remote control apparatuses 104, 105 and 106. (Column 15, Line 35 to Column 16, Line 6). The center apparatus 101 communicates via a CATV network with a plurality of terminal apparatuses 102. (Column 16, Lines 36-39). The terminal apparatus 102 supplies data to the display apparatus 103 and communicates with the remote control apparatuses 104, 105 and 106. (Column 16, Lines 39-47). Each remote control apparatus 104, 105 and 106 is assigned a unique remote control identification number identifying a particular user and stores personal attribute information for the user. (Column 16, Lines 8-10 and Lines 20-25). In addition, each terminal apparatus 102 is assigned a unique terminal identification number. (Column 16, Lines 11-13). The center apparatus 101 stores the terminal identification number and associated remote control identification numbers. (Column 16, Lines 14-20).

Each remote control apparatus 104, 105 and 106 can further be provided with user identification means, such as a password, fingerprint recognition or voice pattern recognition. (Column 7, Lines 14-22; Column 24, Line 66 to Column 25, Line 5; Column 25, Lines 55-59; and Column 26, Lines 15-17). Before inputting message data to be sent to the center apparatus 101, the user first inputs the necessary user-identification information to the remote control apparatus

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

104, 105 or 106, which compares the received user-identification information to stored user-identification information to authorize the user. (Column 25, Lines 5-11). If the user is authorized, the user personal information and remote control apparatus identifier are read out and attached to a service request sent to the terminal apparatus 102, which in turn forwards the service request to the center apparatus 101. (Column 7, Lines 24-30; Column 25, Lines 12-22).

F. CLAIMS 5-11 AND CLAIMS 13-16

For the reasons set forth below, the Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to Claims 5-11 and Claims 13-16.

The Appellant respectfully traverses the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by *Nakano* to include elements of the device taught by *Harada*. Specifically, the Appellant traverses the Examiner's assertion that "It would have been obvious to one with ordinary skill in the art to include to Nakano et al bio-authentication information as the identification information because Harada et al teaches selectively controlling access (i.e. adults and children; col 4, lines 42-60). (January 11, 2005 Office Action, Page 5, Lines 3-6).

The supposed motivation to "selectively control access" is very general and does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

combine reference teachings. The desire to “selectively control access” is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. *Nakano* does not disclose the concept of using bio-authentication information. *Harada* does not disclose the concept of a consumer electronics device having a local processor that operates in the manner as claimed by the Appellant. There is no suggestion or motivation to combine the teachings of the *Nakano* reference with the teachings of the *Harada* reference.

The supposed motivation of “selectively controlling access” does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Appellant’s invention.

Even if the *Nakano* reference could somehow be combined with the *Harada* reference, the combination would not teach, suggest, or even hint at the Appellant’s invention as set forth in Claims 5-11 and Claims 13-16. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an Appellant’s disclosure. In the present case, the *Nakano* reference and the *Harada* reference in combination would not teach or suggest all the claim limitations of the Appellant’s invention.

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

The Appellant's device as claimed in Claim 5 comprises "a bioauthentication device which provides bioauthentication information to the memory" of the device. The *Dethloff* M-card does not comprise a device within the *Dethloff* M-card that provides bioauthentication information to the memory of the *Dethloff* M-card.

The Examiner stated that the *Dethloff* reference discloses "sending account holder information over the communication link, a match detected and determining a sub-credit limit that is not exceeded (col 13, lines 67-68; col 14, lines 1-8). (January 11, 2005 Office Action, Page 3, Line 18 to Page 4, Line 2). The Appellant respectfully traverses this assertion of the Examiner.

The cited portion of the *Dethloff* reference reads:

The procedure is in principle as follows
the machine checks the card authenticity;
the card checks the sub-user's identity (upon sub-user's inputting his/her PIN);
the card accepting machine checks available funds (to sub-user) and the term (sub-user's authorization terminating data; and;
if ok for funds and term, the card accepting device executes the transaction and updates the sub-user's transaction memory within the card.
(*Dethloff*, Column 13, Line 67 to Column 14, Line 8).

From the portion of the *Dethloff* reference cited above it is clear that the "card accepting machine" is external to the *Dethloff* M-card and that the "card accepting machine" contains the sub-credit limit information against which it checks the "available funds (to sub-user)." Therefore, it is clear that the "card accepting machine" receives the user's account holder information over the communication link before the card accepting machine determines whether

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

there are "available funds (to sub-user)" (i.e., that the sub-credit limit is not exceeded). Therefore, the *Dethloff* M-card does not operate in the manner of the Appellant's invention.

The Appellant respectfully submits that the alleged motivation to combine the *Nakano* reference and the *Harada* reference and the *Dethloff* reference presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Appellant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that "It would have been obvious to one with ordinary skill in the art to include bio-authentication information as the identification information further as a voice sensor because Harada et al teaches such for privacy purposes (col 3, line 10-12) and non-eligible user participation (col 3, lines 40-42). (January 11, 2005 Office Action, Page 4, Lines 3-6). The Appellant respectfully traverses this assertion of the Examiner. The supposed motivations of "privacy purposes" and of "non-eligible user participation" are very general and do not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Dethloff* reference and with the teachings of the *Harada* reference. The fact that three references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Appellant's invention.

There is no "clear and particular" motivation (as required by the applicable law) to combine the concepts of bio-authentication as disclosed by *Dethloff* and by *Harada* with the account authorization device as disclosed by *Nakano*.

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

The Examiner stated that "It would have been obvious to one with ordinary skill in the art to include to Nakano et al a bio-authentication device for providing the bio-authentication information as fingerprint sensor because Dethloff et al teaches bioauthentication and Nakano et al teaches controlled access." (January 11, 2005 Office Action, Page 5, Lines 7-10). The Appellant respectfully traverses this assertion of the Examiner. The supposed motivation to combine references is missing. The fact that *Dethloff* may teach bioauthentication and that Nakano may teach "controlled access" does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Dethloff* reference. The fact that two references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Appellant's invention.

The Examiner stated that "It would have been obvious to one with ordinary skill in the art to a local storage device for memory and further where the memory is part of the consumer electronics device because Harada et al teaches multiple user information at the consumer electronics device for relational identification (col 17, lines 64-67). (January 11, 2005 Office Action, Page 4, Lines 7-10). The Appellant respectfully traverses this assertion of the Examiner. The supposed motivation to combine references is missing. The fact that *Harada* may teach the use of "multiple user information at the consumer electronics device for relational identification" does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the

DOCKET No. US 000377
U.S. SERIAL No. 09/734,808
PATENT

Harada reference. The fact that two references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Appellant's invention.

The Examiner stated that "It would have been obvious to one with ordinary skill in the art to include sending account holder information over the communication link only if the match is detected and determining a sub-credit limit that is not exceeded from Dethloff et al because *Harada* et al teaches local determination of user as important because personal information must be controlled (col 3, lines 8-9) and since Nakano teaches credit sub-limits which is a type of personal information. (January 11, 2005 Office Action, Page 4, Lines 11-16). The Appellant respectfully traverses this assertion of the Examiner for the reasons set forth below.

Harada does not teach or suggest sub-credit limits or making a determination with respect to the sub-credit limits. The Appellant respectfully submits that personal information does not teach sub-credit limits. However, even if the Examiner's statement that credit sub-limits are a type of personal information is correct, the Examiner has not provided any teaching or suggestion in *Harada* of a determination with respect to the personal information. The remote control apparatus 104, 105 or 106 of *Harada* authorizes a user based on user-identification information. No processing of the personal information at the remote control apparatus 104, 105 or 106 or terminal apparatus 102 is mentioned or suggested in *Harada*. Instead, the personal information is simply sent to the central apparatus 101 in a service request once the user is authorized. Therefore, the teachings of

DOCKET No. US 000377
U.S. SERIAL No. 09/734,808
PATENT

Harada are in effect similar to the teachings of *Nakano*. As a result, the Appellant respectfully submits the Appellant's invention is patentable over the *Nakano* reference and the *Dethloff* reference and the *Harada* reference, either separately or in combination.

Furthermore, the supposed motivation to combine the three references is legally insufficient. The fact that *Harada* may teach that "personal information must be controlled" does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Dethloff* reference or with the teachings of the *Harada* reference. Similarly, the fact that *Nakano* teaches the use of credit sub-limits does provide a legally sufficient motivation to combine references. The fact that two or three references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Appellant's invention.

The Examiner stated "Harada et al discloses bio-authentication information as the identification information where bio-authentication device provides the bio-authentication information that is a fingerprint (col 7, lines 19-23) further where the sensor is on the remote control (col 7 lines 14-18). (January 11, 2005 Office Action, Page 4, Line 17 to Page 5, Line 2). The Appellant respectfully traverses this assertion of the Examiner. The supposed motivation to combine references is missing. The fact that *Harada* may teach the use of "bio-authentication information as the identification information" does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. The fact that two

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Appellant's invention.

Even if the *Nakano* reference could somehow be combined with the *Dethloff* reference and with the *Harada* reference, the combination would not teach, suggest, or even hint at the Appellant's invention as set forth in Claims 5-11 and Claims 13-16. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, the *Nakano* reference and the *Dethloff* reference and the *Harada* reference in combination would not teach or suggest all the claim limitations of the Appellant's invention.

The Appellant respectfully directs the Board's attention to Claim 5.

5. (Previously presented) A consumer electronics device, comprising a memory which stores account information for an account holder and sub-credit limits and bioauthentication information for authorized users of the account; a bioauthentication device which provides bioauthentication information to the memory;

a communication link; and

a processor, which compares received bioauthentication information to stored bioauthentication information to detect a match, and finds an associated sub-credit limit corresponding to the received bioauthentication information, to enable a purchase over the response network via the communication network up to a maximum of the sub-credit limit, the processor sending the account holder information over the communication link only if the match is detected and the

DOCKET No. US 000377
U.S. SERIAL No. 09/734,808
PATENT

sub-credit limit is not exceeded. (Emphasis added).

The Appellant respectfully submits that neither the *Nakano* reference nor the *Dethloff* reference nor the *Harada* reference teaches or suggests all of the claim limitations of Claim 5. The present invention comprises a local account authorization device in a consumer electronics device typically found in the home. In the present invention, the user sets up an account with sub-credit limits in a local consumer electronics device such as a set top box. The credit card information is not sent out on the network until after the bio-authentication information has been locally matched and the sub-credit limit has been locally determined. This element is not disclosed or suggested in the prior art.

Unlike the Appellant's invention, the *Nakano* device sends a charge request from set top box 3 over a communications link to remote server/processor 1. The remotely located server/processor 1 makes the determination with respect to the sub-credit limit. In the Appellant's device the local processor in the consumer electronics device does not send account information over a communication link to a remote location until after the local processor has (1) locally matched the bio-authentication information, and (2) locally determined that the sub-credit limit has not been exceeded. In the *Dethloff* device, the remotely located "card accepting machine" makes the determination with respect to the sub-credit limit.

The Appellant notes that Claims 6-11 depend directly or indirectly from Claim 5. As previously described, Claim 5 contains unique and novel claim limitations of the Appellant's invention. Therefore, Claims 6-11 also contain the same unique and novel claim limitations of

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

Claim 5 and are therefore patentable over the *Nakano* reference and the *Dethloff* reference and the *Harada* reference, either separately or in combination.

The Appellant notes that Claim 13 and Claim 14 contain elements that are analogous to the unique and novel elements of Claim 5 that have been previously discussed. The Appellant further notes that Claims 15-16 depend directly or indirectly from Claim 14. Therefore, Claims 15-16 also contain the same unique and novel claim limitations of Claim 14 and are therefore patentable over the *Nakano* reference and the *Dethloff* reference and the *Harada* reference, either separately or in combination.

The Appellant therefore respectfully submits that Claims 5-11 and Claims 13-16 are in condition for allowance. Allowance of Claims 5-11 and Claims 13-16 is respectfully requested.

AUG 09 2006


DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT**CONCLUSION**

The Appellants have demonstrated that the present invention as claimed is clearly distinguishable over the prior art cited of record. Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Appellants have previously paid the fees associated with the filing of the Appeal Brief. The Appellants do not believe that any additional fees are due. However, the Commissioner is hereby authorized to charge any additional fees (including any extension of time fees) or credit any overpayments to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: Aug 9, 2006

William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: wmunck@munckbutrus.com

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

APPENDIX A

PENDING CLAIMS

RECEIVED
CENTRAL FAX CENTER
AUG 09 2006

1. (Canceled).
2. (Canceled).
3. (Canceled).
4. (Canceled).
5. (Previously presented) A consumer electronics device, comprising
a memory which stores account information for an account holder and sub-credit limits and
bioauthentication information for authorized users of the account;
a bioauthentication device which provides bioauthentication information to the memory;
a communication link; and
a processor, which compares received bioauthentication information to stored
bioauthentication information to detect a match, and finds an associated sub-credit limit
corresponding to the received bioauthentication information, to enable a purchase over the response
network via the communication network up to a maximum of the sub-credit limit, the processor
sending the account holder information over the communication link only if the match is detected
and the sub-credit limit is not exceeded.
6. (Original) The consumer electronics device as claimed in claim 5, wherein the
bioauthentication device is a fingerprint sensor.
7. (Original) The consumer electronics device as claimed in claim 6, wherein the
fingerprint sensor is located on a remote control for the consumer electronics device.

DOCKET NO. US 000377
U.S. SERIAL NO. 09/431,494
PATENT

8. (Original) The consumer electronics device as claimed in claim 5, wherein the bioauthentication device is a voice sensor.

9. (Original) The consumer electronics device as claimed in claim 5, for receiving an advertisement and for causing the advertisement to be displayed, and wherein upon receipt of an authorized user's bioauthentication information the processor initiates a buy command to the advertiser through the communication network.

10. (Original) The consumer electronics device as claimed in claims 5, 6 or 7 wherein the consumer electronics device is a set top box.

11. (Original) The consumer electronics device as claimed in claims 5, 6 or 7 wherein the consumer electronics device is a television.

12. (Canceled).

DOCKET NO. US 000377
U.S. SERIAL NO. 09/431,494
PATENT

13. (Previously presented) A device for locally controlling access to an account, comprising:

- a local storage device for storing account information of an account holder and sub-credit limits and bioauthentication information for authorized users of the account;
- a bioauthentication device for obtaining bioauthentication information from authorized users and an account holder;
- a processor for changing sub-credit limits on the storage device in response to a request from the account holder, provided the account holder has provided bioauthentication information which matches bioauthentication information stored on the local storage device for the account holder, and
- a communication network for authorizing a transaction on the account and sending the account holder's information in response to a request from an authorized user or account holder provided that the bioauthentication information provided by the authorized user or account holder matches the bioauthentication information of the authorized user or account holder stored on the local storage device and that the transaction does not exceed the sub-credit limit storage on the local storage device of the authorized user or account holder making the request.

DOCKET NO. US 000377
U.S. SERIAL NO. 09/431,494
PATENT

14. (Previously presented) A consumer electronics device, comprising:

- a memory which stores a profile of a user, the profile indicates access levels of the user, and sub credit limits of authorized users of an account;
- a bioauthentication device which provides bioauthentication information to the memory;
- a communication link, and
- a processor, which compares received

bioauthentication information to stored bioauthentication information to detect a match, and detects the access levels of the profile associated with the matching bioauthentication information to determine whether requested access over the communication link can be given based on the received bioauthentication information, and whether the subcredit limit associated with the received bioauthentication information is enough to complete a requested transaction and sending the account holder information across the communication link only if there is a match and the subcredit limit it not exceeded.

15. (Original) The consumer electronics device as claimed is claim 14, wherein the memory also stores bioauthentication information of a profile maker, and wherein upon receipt of the profile maker's bioauthentication information the processor permits the profiles in the memory to be modified by the profile maker.

16. (Original) The consumer electronics device as claimed in claim 15, wherein the profile holds parental control information.

17. (Canceled).

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

APPENDIX B

EVIDENCE APPENDIX

None

THIS PAGE BLANK (USPTO)

DOCKET NO. US 000377
U.S. SERIAL NO. 09/734,808
PATENT

APPENDIX C

RELATED PROCEEDINGS APPENDIX

None

THIS PAGE BLANK (USPTO)

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

☒ **BLACK BORDERS**

☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**

☐ **FADED TEXT OR DRAWING**

☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**

☐ **SKEWED/SLANTED IMAGES**

☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**

☐ **GRAY SCALE DOCUMENTS**

☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**

☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**

☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.